REMARKS

This paper is filed in response to the Examiner's Action mailed 02 February 2004.

The application was initially filed on 03 April 2000 with sixteen claims. Upon the examination, the Examiner, in an Office Action mailed 14 February 2003, rejected claim 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,249,291 B1 entitled METHOD AND APPARATUS FOR MANAGING INTERNET TRANSACTIONS to Popp et al. (Popp '291). The Examiner further rejected claims 1-11 and 13-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,368,273 B1 entitled NETWORKED SYSTEM FOR INTERACTIVE COMMUNICATION AND REMOTE MONITORING OF INDIVIDUALS to Brown (Brown '273) in view of U.S. Patent 6,516,353 B1 entitled SYSTEM AND METHOD FOR INTERACTIVE EDI TRANSACTIONS to Richards (Richards '353). Applicant amended claims 1, 4, 5, 6, 13, and 16, and cancelled claim 2 to represent that the script remains and executes on the server. Applicant further amended claims 1 and 12 to represent that different policies of different desktop/containers are contemplated within the claim and thus those user-interface components are downloaded within the unique policy framework of each desktop/container. The Examiner issued a final rejection of claims 1-11, 13-16 under 35 U.S.C. §103(a) as being unpatentable over Brown'273 in view of Richards '353. Claims 12 was finally rejected under 35 U.S.C. §103(a) as being unpatentable over Popp '291 in view of Brown '273.

Applicants filed a Request for Continued Examination under 35 U.S.C. §1.114 with an amendment on 06 November 2003. Upon Examination of the RCE, the Examiner rejects claims 1-11, 13-16 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication US 2003/0145049 A1 entitled METHOD AND SYSTEM FOR TRANSFERRING JOB BETWEEN COMPUTERS to Hirabayashi (Hirabayashi '049), and further rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Popp '291 in view of Hirabayashi '049.

The Rejection of claims 1-11, 13-16 under 35 U.S.C. §102(e)

The Examiner further rejected claims 1-11 and 13-16 under 35 U.S.C. §102(e) as being anticipated by Hirabayashi '049. The statute 35 U.S.C. §102(e) is provided:

> A person shall be entitled to a patent unless –
> (e) the invention was described in –
> (1) an application for patent, published under section 122(b) by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the application for patent, except than an international application filed under the treaty defined in section 351(a) [the Patent Cooperation Treaty] shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2)(a) of such treaty in the English language; or ...

Respectfully, the reference Hirabayashi '049 publication cannot be used as a reference to negate patentability under 35 U.S.C. §102(e)(1). Hirabayashi '049 claims priority under 35 U.S.C. §119 of a foreign patent application filed in Japan on 22 April 1999. The statute reads:

> 35 U.S.C. 119 Benefit of earlier filing date; right of priority.
> (a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; ....

The Examiner, however, is rejecting Applicant's claims under 35 U.S.C. §§ 102(e) and 103(a). It has long been established that "section 119 does not modify the express provision of section 102(e) that a reference patent is effective as of the date the

application for it was 'filed in the United States.'" In re Hilmer, Korger, Weyer, and Aumuller, 359 F.2d 859, 149 USPQ 480, 482 (CCPA 1966) (Hilmer I). *See also* In re In re Hilmer, Korger, Weyer and Aumuller, 424 F.2d 1108, 165 USPQ 255, 256 (CCPA 1970) (Hilmer II) which states "In Hilmer I, the question we decided was whether the Habicht patent [Hirabayashi '049 publication] was effective as a *prior art* reference under 35 U.S.C. 102(e) as of the Swiss [Japanese] filing date. We held that it was not and that it was 'prior art' under 102(e) only as of the U. S. filing date, which Hilmer [Applicant] could overcome by being entitled to rely on the filing date of his German [U.S.] application, to show his date of invention." Applicants respectfully requests the Examiner to reread the above remarks and replace those phrases in parenthesis ( ) with those phrases in brackets [ ]. The Examiner can clearly then understand that Hirabayashi '049's Japanese filing date does not establish it as "prior art" under 35 U.S.C. §§ 102(e) and 103(a). Hilmer I is still good law and right on point to this application; quite simply, a foreign priority date does not establish that the application was filed in the United States.

Hirabayashi '049, moreover, does not satisfy the requirements of 35 U.S.C. §102(e)(1) or (2). First, Hirabayashi '049 does not meet the criterion of 35 U.S.C. §102(e)(1) because Hirabayashi '049 was NOT filed in the United States before the invention by the application for patent. Hirabayashi '049 was filed in the United States on 21 April 2000, *see* Hirabayashi '049 which states at "(63) Continuation of application No. 09/812,781, filed on Mar. 15, 2001, which is a continuation of application No. 09/553,762, filed on Apr. 21, 2000, now Pat. No. 6,549,936." Applicant filed this patent application on 03 April 2000, almost three weeks before Hirabayashi '049's parent application No. 09/553,762 was filed in the United States on 21 April 2000. Thus, Hirabayashi '049 cannot be used as prior art under 35 U.S.C. §102(e)(1).

The Hirabayashi '049 reference, moreover, cannot negate patentability under 35 U.S.C. §102(e)(2) because Hirabayashi '049 does not fulfill the criterion of 35 U.S.C. §102(e)(2). The first U.S. application of Hirabayashi '049 was filed on 21 April 2000, after Applicant filed his application. Hirabayashi '049, however, cites "(3) Foreign Application Priority Data Apr. 22, 1999 (JP) 11-114335." Applicant has researched this

foreign application; respectfully, this foreign application does NOT satisfy the exception provided in 35 U.S.C. §102(e)(2). The first requirement for a foreign application to be considered under 35 U.S.C. §102(e)(2) is that it be an international application filed under the treaty defined in section 351(a), i.e., the Patent Cooperation Treaty (PCT). The application upon which Hirabayashi '049 is based was filed as a national Japanese patent application, not a PCT application. A second requirement for a foreign application to be considered under 35 U.S.C. §102(e)(2) is that the international PCT application designate the United States. Hirabayashi '049 and its Japanese parent application did not designate the United States. A last requirement for Hirayabashi '049 to preclude patentability of Applicant's application under 35 U.S.C. §102(e)(2) is that the international application be published under Article 21(2) of the PCT in the English language, something that was never done with the Japanese parent application. Indeed, the first time the application was ever published in English was 25 October 2000 when EP1046989, the European counterpart application of JP 11-114335, was published. Note that this date too antedates Applicant's filing date in the U.S.

In summary, Hirabayashi '049 and its foreign parent application JP 11-114335 cannot be used to reject Applicant's claims under 35 U.S.C. §102(e). First, a foreign priority date of a national patent application under 35 U.S.C. §119 cannot override the explicit requirement of 35 U.S.C. §102(e) that the reference be "filed in the United States before the invention by the application." Hilmer I. Second, under the requirements of 35 U.S.C. §102(e)(1) which is a statutory affirmation of Hilmer I, Hirabayashi '049 was not filed in this country before the invention by the Applicant for patent. And lastly, under the exception allowed by 35 U.S.C. §102(e)(2), Hirabayashi '049 was not filed under the Patent Cooperation Treaty under section 351(a), nor was the United States ever a designated country, nor was the application ever published in English under the articles of the PCT. Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-11 and 12-16 under 35 U.S.C. §§102(e) and/or 35 U.S.C. 103(a).

The Rejection of claim 12 under 35 U.S.C. §103(a)

The Examiner further rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Popp '291 in view of Hirabayashi '049. The Examiner maintains that Popp '291 discloses a method to script user-interface components to create an application stored on a server and whose user-interface components are downloaded to one of a variety of container/desktops of different clients. Applicant asserted and the Examiner admitted that Popp '291 does not disclose or suggest the claimed language of each one policy framework being unique to one of said variety of container/desktops of different clients and downloading to container/desktop of said client and in accordance with the policy framework unique to said container/desktop of said client, as in claim 12.

The Examiner then asserts that Hirabayashi '049 discloses this feature. Applicant respectfully reasserts that Hirabayashi '049 cannot sustain a rejection under 35 U.S.C. §103(a), either alone or combined with Popp '291, because Hirabayashi '049 was filed in the U.S. after Applicant filed his application, i.e., after Applicant invented his invention. The Japanese patent application, moreover, was not filed under the Patent Cooperation Treaty, did not designate the U.S. as a country, and was not published in English under the PCT. Respectfully, Applicant requests the Examiner to withdraw the rejection of claim 12 under 35 U.S.C. §103(a) under the combination of Popp '291 and Hirabayashi '049.

Additional Technical Differences

Hirabayashi '049 downloads scripts all at once from a first computer (which acts as a server) and executes the scripts on a second computer (acting as a client). In contrast, the present invention does not download scripts to a client machine, but rather downloads user-interface components. As per the present claims, the scripts associated with the user-interface components are executed on the server, not on a client.

Hirabayashi '049 cannot be combined with Popp '291 because Hirabayashi '049 transfers the script with the requrest and executes the script. Hirabayashi '049 is characterized by a first computer (server) sending scripts to a second computer (client)

and having the second computer (client) execute the scripts. As per the present claims, the client does not execute the scripts, and the scripts are not downloaded to the client.

Conclusion

Applicant respectfully request the Examiner to review the remarks and to pass the application to issuance because Hirabayashi '049 cannot be used as prior art under 35 U.S.C. §§ 102(e) or 103(a). The Examiner is further invited to telephone the Attorney listed below if she thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,

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